UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/661,578
Filing Date: September 14, 2000
Appellant(s): EUBANKS, GINA C.

MAILED

JUN 1 2 2006

Technology Center 2100

William A. Zarbis
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For Appellant

EXAMINER'S ANSWER

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

This is in response to the appeal brief filed 3/15/2006 appealing from the Office

action mailed 11/2/2006.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is

correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,341,353	HERMAN ET AL	1-2002
6,836,799	PHILYAW ET AL	12-2004

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Herman et al., US pat. No.6,341,353 (hereafter Herman) in view of Philyaw et al., U.S.

pat. No.6,836,799 (hereafter Philyaw).

As to claim 1, Herman discloses a computer-implemented method for facilitating a

transaction between a subscriber (30 fig.2) and a vendor (70 fig.2) through an

intermediary (Broker 40 fig.2), said method comprising the steps of:

receiving at said intermediary (40 fig.2) personal information from said

subscriber to establish a user account and storing said personal information for

subsequent access (using a registration form to identify user information, see fig.2, col.3

line 55 to col.4 line 38 and col.6 lines 2-31).

receiving at said intermediary a request from said subscriber to access

(customer access) said user account, whereupon said subscriber's identity is verified by

said intermediary against said personal information (validating users, see col.6 lines 32-

63).

responsive to successful verification of said subscriber's identity (determining if

the transaction of user is valid), said intermediary conducting a transaction with said

vendor on behalf of said subscriber pursuant to said subscriber's instruction, wherein

said transaction is conducted utilizing information about said intermediary and notifying

said subscriber upon completion of said transaction (issuing an OK or a rejection, see

col.6 line 64 to col.7 line 67).

Herman does not specifically disclose that a transaction is completed without disclosing

personal information about a subscriber to a vendor. However, Philyaw in the same

network monitoring environment discloses that a transaction is completed without

disclosing personal information about a subscriber to a vendor [transmitting only user ID

(identifier ID 1304 fig.13) associated with a user to other network server/device instead

of user information/ID associated with the user], see fig.13, col.12 line 27 to col.13 line

21 and col.14 lines 13-62). It would have been obvious to one of the ordinary skill in the

art at the time the invention was made to incorporate Philyaw's teachings into the

computer system of Herman to monitor user interactions in the network because it

would have allowed a network administrator/manufacture to place an advertisement in

magazine or to place a product on a shelf at a particular time and to obtain users'

demographics information in a relatively short time (see Philyaw's col.14 line 63 to

col.15 line 33).

As to claim 2, Herman discloses preparing an account activity statement for said

subscriber, wherein said account activity statement includes information about

transactions completed through said user account during a statement period

(implementing a Unit ID, Owner ID and Payload regarding user characteristics, price, revenue model and transactions, see fig.7, col.8 line 19 to col.9 line 58).

As to claim 3, Herman discloses receiving at said intermediary an item ordered from said vendor on behalf of said subscriber pursuant to said subscriber's instruction and billing said subscriber for services (processing customers' ID products) rendered (see fig.7, col.9 line 21 to col.10 line 54 and col.23 line 31 to col.24 line 53).

As to claims 4 and 5, Herman discloses notifying said subscriber upon receipt of said item and holding said item for pick-up by said subscriber and shipping said item to said subscriber specifying payment and shipping information (verifying payment and shipping information according to user preferences using the Trusted Agent Server, see fig.19, col.43 line 4 to col.44 line 64 and col.46 lines 11-60).

As to claims 6 and 7, Herman discloses receiving at said intermediary a post-delivery request from said subscriber, said post-delivery request relating to said item and handling said post-delivery request on behalf of said subscriber and consisting of a return request, a repair request, an exchange request, <u>a warranty submission request</u> and a rebate request (checking for warranty information, see fig.19, col.43 line 4 to col.44 line 64 and col.46 lines 11-60).

As to claim 8, Herman discloses maintaining at said intermediary rating information

about said vendor and providing said rating information to said subscriber (see fig.19,

col.43 line 4 to col.44 line 64 and col.46 lines 11-60).

As to claims 9 and 10, Herman discloses providing purchase financing to said

subscriber in said transaction over the Internet (60 fig.2) (see fig.2, col.4 lines 7-61).

Claims 11-20 are rejected for the same reasons set forth in claims 1-10 respectively.

Claims 21-28 are rejected for the same reasons set forth in claims 1-7 and 10

respectively.

As to claim 29 and 30, Herman further discloses transaction comprising of purchasing

an item and a financial transaction (using Storekeeper service including an inventory's

list, sales log of transactions, see col.17 lines 24-64 and col.46 lines 11-60).

Response to Arguments

Appellant has chosen to group the claims into 2 groups for argument:

Group I: Claims 1, 11 and 21.

Group II: Claims 2-10, 12-20, 22-30.

Regarding Group I, pages 4-7 of the Appeal Brief are directed to these claims.

- Appellant argues that Herman does not disclose "the intermediary conducts a transaction with a vendor on behalf of the subscriber pursuant to the subscriber instruction utilizing an account of the intermediary <u>without disclosing the personal information about the subscriber to the vendor</u>".

Firstly, Appellant is reminded that the claims' limitations are rejected under 35 U.S.C 103(a) with the combination of <u>two references</u> (Herman in view of Philyaw), not only one reference (Herman) as in Appellant's argument.

Secondly, Examiner respectfully points out that the combination of Herman and Philyaw discloses the Applicant's claimed limitations. For example, Herman discloses a shopping online across the Internet comprising: receiving personal information at said intermediary (40 fig.2) from said subscriber to establish a user account and storing said personal information for subsequent access (using a registration form to identify user information, see fig.2, col.3 line 55 to col.4 line 38 and col.6 lines 2-31) and validating users upon customer's access [see col.6 lines

32-63), determining if the transaction of user is valid and issuing an OK or a rejection

for customer's transaction (see col.6 line 64 to col.7 line 67).

Herman does not specifically disclose a transaction is completed without disclosing

personal information about a subscriber to a vendor. However, Philyaw in the same

network monitoring environment discloses a transaction is completed without disclosing

personal information about a subscriber to a vendor [transmitting user ID (1304 fig.13)

associated with a user to other network server/device instead of user information, see

fig.13, col.12 line 27 to col.13 line 21 and col.14 lines 13-62). It would have been

obvious to one of the ordinary skill in the art at the time the invention was made to

incorporate Philyaw's teachings into the computer system of Herman to monitor user

interactions in the network because it would have allowed a network

administrator/manufacture to place an advertisement in magazine or to place a product

on a shelf at a particular time and to obtain users' demographics information in a

relatively short time (see Philyaw's col.14 line 63 to col.15 line 33).

- Appellant argues that Philyaw does not disclose "without disclosing personal
  information about a subscriber to a vendor".
  Examiner respectfully disagrees. Philyaw discloses the applicant's claimed
  invention. For example, after a user profile was created, storing user profile in a
  profile database (1302 fig.13) and using only a associated ID of the user profile
  when connecting to remote locations throughout a communication network.
  Specifically, Philyaw discloses transmitting only a user ID (1304 fig.13)

associated with a user profile to other network server/device instead of using

user profile information again (happening during set up user ID). The program

then can operate without requiring all the setup information at later time (see

fig.13, col.12 line 27 to col.13 line 21 and col.14 lines 4-62). This is equivalent to

what is claimed. Therefore, the claims are properly rejected.

As a result, the cited prior art do discloses a system and method for the

intermediary and the vendor directly conducts the transaction with each other without

disclosing the personal information about the subscriber, as broadly claimed by the

Applicants. Applicants clearly have still failed to identify specific claim limitations that

would define a clearly patentable distinction over prior art.

Regarding Group II, pages 7-8 of the Appeal Brief are directed to these claims.

There is no argument in the Group II (dependent claims 2-10, 12-20, 22-30)

since the Appellant relies mostly on Group I (independent claims 1, 11 and 21).

Therefore, claims 2-10, 12-20, 22-30 are rejected for the similar reasons set forth in

claims 1, 11 and 21, and reasons set forth in the above rejection, supra.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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ZARNI MAUNG
SUPERVISORY PATENT EXAMINER

Conferees:

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